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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,052	06/26/2001	Wolfgang Fritz	HOE605	1771

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5955 W. Main Street
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EXAMINER

COMPTON, ERIC B

ART UNIT	PAPER NUMBER
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3726

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DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,052

Applicant(s)

FRITZ, WOLFGANG

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Drawings

1. Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. The specification refers "a conventional follow-on combination tool," with regards to Figure 2. (page 12, fourth full paragraph). The Examiner is not quite sure whether Figures 1, and 4-6 are Prior Art as well, since the specification seems to suggest these figures depict the conventional process. Applicant is requested to designate these as such, if this is the case also.

Specification

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)),

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and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).

"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 19-23 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art (AAPA).

Claim 19-23, based on claim 9, only requires a gasket comprising a single layer or multiple layers having a contour line.

AAPA, as found on page 1 and page 12, fourth full paragraph to page 14, fourth full paragraph, discloses that gaskets of this type are known.

Note: the method of forming the device is not germane to the issue of patentability of the device itself. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-17 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of DE 884936 ('936).

AAPA, as found on page 12, fourth full paragraph to page 14, fourth full paragraph, in reference to Figure 2, describes the conventional device (and process) for the production of gasket plate, having a follow-on combination tool (114) with several machining stations (122), a feeding device (106), and a tools for cutting the outer contour lines. Page 2, second paragraph, discloses, "Devices of this type are known from the state of the art."

However, the AAPA does not disclose that the facing outer contour lines of adjacent gasket layers are cut by a single tool using a the same cutting edge.

An oral translation of DE '936, reveals that the invention discloses a device (and process) for the production of fittings (a) for furniture. A sheet of metal (b) is feed to a combination tool (see Fig 1), having multiple punches (f,g,h,i). In the final step, a section is cut from the sheet by the punch (i), which cuts the contour lines of adjacent sections using the same cutting edge. It is inherent that a feeding device is provided that moves the section (a) to become fittings through the combination tool by a feed distance equal to the width of one section.

Regarding claims 1, 5, 6, 8, and 9, 13, 14, 16, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the gasket layer of AAPA, by a device (and process) wherein the facing outer contour lines of adjacent gasket layers are cut by a single tool using a the same cutting edge, in light of the teachings of DE '936, in order to reduce waste material between adjacent layers in the prior art.

Regarding claims 2-4 and 10-12, both AAPA and DE '936 disclose a feed cutting station (138, and f, respectively) arranged in front station for cutting the outer contour lines, and transverse to the cutting station.

Regarding claims 7 and 15, the angle between the edges of the cutting tool (f) of DE '936 are not disclosed. The cutting angle effects the overall cutting of the contour lines. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the cutting angle 90 degrees, since it has been held

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that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 17, AAPA discloses gaskets having multiple layers.

Regarding claim 18, AAPA discloses gaskets having multiple layers. However, they do not disclose that the outer contour lines of adjacent layers essentially point symmetric to one another.

Regarding claims 19-23, the product claimed is inherently produced by the process of AAPA/DE '936. Furthermore, the method of forming the device is not germane to the issue of patentability of the device itself. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/DE '936 in view of either US Paten 4,862,574 to Seidy, US Patent 3,998,300 to Sullivan, or US Pat 3,822,461 to Malmstrom.

AAPA/DE '936 discloses the invention cited above, specifically AAPA discloses gaskets having multiple layers. However, they do not disclose that the outer contour lines of adjacent layers essentially point symmetric to one another.

Siedy, Sullivan, and Malmstrom, all teach fabricating products from sheet material and subsequently cutting along an outer contour line of the adjacent product. Furthermore, the outer contour lines of the adjacent products have been designed to essentially point symmetric to one another. Such a design allows for products having non-linear contour lines to be packed densely without waste material between adjacent products.

Regarding claim 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have designed the outer contour lines of adjacent layers to point symmetric to one another, in light of the teachings of either Siedy, Sullivan, or Malmstrom, in order to provide a greater packing density, without waste between adjacent products.

Prior Art References

The prior art references listed on the enclosed PTO-892, but not used in a rejection of the claims, are cited for their teachings of methods for forming gaskets.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory M. Vidovich can be reached on (703) 308-1513. The fax phone


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numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ebc

May 14, 2003


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700